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09/815,819	03/23/2001	Wendell Brown	EVOI0009	6685

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EXAMINER

PHAN, JOSEPH T

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/815,819

Applicant(s)

BROWN ET AL.

Examiner

Joseph T Phan

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 March 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3                      6) ☐ Other:

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 10 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 lines 3-5 recites "executing one of a...module to allow communication between the user and the caller in the direction opposite to said one-way" It is unclear and confusing as to the claimed limitation of communicating in a 'direction opposite to said one-way'. If 'direction opposite to said one-way' is referring to the caller communicating to the user by using either module, examiner requests applicant to give references from the specification to support the executing of a module to perform this capability by the caller. Appropriate clarification or correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1-36 rejected under 35 U.S.C. 102(b) as being anticipated by McMullin, Patent #5,809,128.**

Regarding claims 1 and 29, McMullin teaches a method and a computer readable storage medium storing instructions for controlling a telephone call to an instant messaging user, comprising:

receiving at a call server a call directed to the user and identifying an instant messaging service used by the user (col.3 line 36- col.4 line 22);

sending an instant message to the user through the instant messaging service to offer the user one or more options for responding to the call (col.3 lines 43-67);

if no response is received from the user within a predetermined period of time, controlling the call as specified in a default option (col.10 lines 51-65); and otherwise: receiving an option selection from the user; and controlling the call as specified in said selected option (col. 3 lines 43-67).

Regarding claim 2, McMullin teaches the method of claim 1, further comprising determining a user name of the user for the instant messaging service (col.9 lines 8-35).

Regarding claim 3, McMullin teaches the method of claim 1, wherein said one or more options include one or more of the set of transfer the call, answer the call, take a message from the caller and play a message for the caller (col.3 lines 43-67).

Regarding claim 4, McMullin teaches the method of claim 1, wherein said option selection is received in an instant message from the user (col.3 lines 43-67).

Regarding claim 5, McMullin teaches the method of claim 1, wherein said selected option is presented in said instant message as a hyperlink and said receiving said option selection comprises receiving a communication connection initiated by the

user's selection of said selected option (*col.10 lines 40-65; clicking on an option on the pop-up screen is a hyperlink to the selected action*).

Regarding claim 6, McMullin teaches the method of claim 1, wherein said selected option is to play a message for the caller, the method further comprising recording a message from the user (col.5 lines 11-16, col.7 lines 33-36, and col.9 lines 46-63)

Regarding claim 7, McMullin teaches the method of claim 1, wherein said selected option is to play a message for the caller and said controlling comprises: converting a textual message provided by the user into audio; and playing said converted message for the caller (*col.7 lines 50-56 and col.11 lines 1-17; furthermore, can read on the user clicking on the text messages option to play audio to the caller*).

Regarding claim 8, McMullin teaches the method of claim 1, wherein said selected option is to answer the call and said controlling comprises: establishing an audio connection between the user and said call server; and bridging the call onto said audio connection (col.11 lines 9-56).

Regarding claim 9, McMullin teaches the method of claim 8, wherein said audio connection is established through the instant messaging service without further action by the caller (col.11 lines 50-56).

Regarding claim 10, McMullin teaches the method of claim 8, wherein the user is equipped for only one-way audio and said controlling further comprises:

executing one of a text-to-speech module and a speech-to-text module to allow communication between the user and the caller in the direction opposite to said one-way (col.3 lines 43-67, col.7 lines 50-56).

**Regarding claim 11, McMullin teaches** a method of handling a telephone call for a subscriber, comprising:

receiving at a call server a call for a subscriber and identifying a first computer-implemented instant messaging system used by the subscriber (col.3 line 36- col.4 line 22);

sending a first instant message to the subscriber through the instant messaging system, wherein said first instant message includes a first set of options for handling the call and one or more of said first set of call handling options comprise links to said call server(col.3 lines 43-67);

if the subscriber selects one of said first set of call handling options:

receiving a communication connection from the subscriber, wherein said connection is initiated by the subscriber's selection of a call handling option that comprises a link; and

handling the call as specified in said selected call handling option (col.3 lines 60-67).

**Regarding claim 12, McMullin** teaches the method of claim 11, further comprising:

if the subscriber does not respond to said first instant message within a predetermined period of time, handling the call as specified in a default call handling option (col.10 lines 51-65).

Regarding claim 13, McMullin teaches the method of claim 11, further comprising: identifying the user by an original called number field of the call (col.9 lines 8-46).

Regarding claim 14, McMullin teaches the method of claim 11, further comprising: identifying the caller by a caller identification field of the call; wherein said first instant message includes an identifier of the caller (col.3 lines 47-52).

Regarding claim 15, McMullin teaches the method of claim 11, wherein said links are hyperlinks to said call server (*col.3 lines 53-67 and col.10 line 40-col.11 line 8; selecting options via computer screen are hyperlinks to link to the selected action*).

Regarding claim 16, McMullin teaches the method of claim 11, wherein said receiving a call comprises receiving a call forwarded to said call server from a subscriber number originally dialed by the caller (col.8 lines 25-65).

Regarding claim 17, McMullin teaches the method of claim 11, further comprising retrieving user names of the subscriber for one or more instant messaging systems (col.9 lines 17-46).

Regarding claim 18, McMullin teaches the method of claim 11, further comprising sending a second instant message to the subscriber through an instant messaging system different from said first instant messaging system, wherein said second instant message comprises a second set of call handling options (*Fig.4 options, col.9 line 64-col.10 line 4, and col.10 lines 26-39 or can read on col.8 line 39-col.9 line 16, or col.11 lines 9-27; eg. when the subscriber is unavailable(either not answering or busy, the call can be routed to a different number or the caller can call another number used by the*

*subscriber-a PDA is a form of a pager and computer and can be used in the same manner by the subscriber to handle calls which can receive a separate instant message with a second set of call handling options).*

Regarding claim 19, McMullin teaches the method of claim 18, further comprising: if the subscriber selects one of said second set of call handling options: receiving a return instant message from the subscriber, wherein said return instant message includes an identifier of a call handling option selected by the subscriber; and handling the call as specified in said selected call handling option (col.10 lines 5-25 and lines 40-67).

Regarding claim 20, McMullin teaches the method of claim 11, wherein said selected call handling option comprises transferring the call and said handling the call comprises: transferring the call from said call server to a telephone number identified by the subscriber (col.3 lines 60-67).

Regarding claim 21, McMullin teaches the method of claim 11, wherein said selected call handling option comprises playing a message for the caller and said handling the call comprises: playing a message identified by the subscriber for the caller (col.7 lines 33-67).

Regarding claim 22, McMullin teaches the method of claim 21, further comprising converting said identified message from text to audio prior to said playing (*col.7 lines 50-67; subscriber selects text from screen to audibly play to caller*).

Regarding claim 23, McMullin teaches the method of claim 21, further comprising recording said message prior to said playing (col.7 lines 50-67).



Regarding claim 24, McMullin teaches the method of claim 11, wherein said selected call handling option comprises answering the call and said handling the call comprises:  
establishing an audio connection between said call server and the subscriber, without further action on the part of the caller; and bridging the call onto said audio connection (col.11 lines 28-56).

Regarding claim 25, McMullin teaches the method of claim 24, wherein said device is not configured for two-way audio and said establishing an audio connection comprises:  
operating one of a text-to-speech module and a speech-to-text module (38 Fig. 2, col.7 lines 50-67; *subscriber selects text from screen which plays speech to caller, therefore is a text-to-speech module*).

Regarding claim 26, McMullin teaches the method of claim 24, wherein said establishing an audio connection comprises establishing an audio connection between said call server and a communication device on which the subscriber received said first instant message (col.11 lines 28-56).

Regarding claim 27, McMullin teaches the method of claim 11, wherein said selected call handling option comprises taking a voicemail message from the caller and said handling the call comprises:  
connecting the call to a voice recording module; and recording a message from the caller (col.3 lines 60-67).

Regarding claim 28, McMullin teaches the method of claim 27, wherein the subscriber chooses to screen said voicemail message, the method further comprising establishing an audio connection between said call server and the subscriber; and bridging said audio connection onto said voice recording connection (*col.3 lines 60-67, col.9 lines 46-63, and col.11 lines 28-56; it is understood that voice messaging systems allows subscribers to screen voicemail and pick up calls*).

Regarding claim 30, McMullin teaches a call control system for handling calls in real-time, comprising:

- a call receiver module configured to receive a call directed to a subscriber (38 Fig.2);
- a database of subscriber profiles, wherein a profile for a first subscriber includes one or more user names of the first subscriber for one or more instant messaging systems (col.9 lines 8-46);
- an instant messaging module configured to send an initial instant messaging message to the first subscriber in response to receipt of a call for the first subscriber from a caller, wherein said initial instant messaging message includes a set of options for handling the call (38 Fig.2 and col.3 lines 36-67);
- a voicemail module configured to record an incoming message from the caller if the first subscriber selects a voicemail option for handling the call; and a message playback module configured to play an outgoing message for the caller if the first subscriber selects a message playback option for handling the call (col.3 lines 36-67 and col.7 lines 50-67).

Regarding claim 31, McMullin teaches the call control system of claim 30, wherein one or more of said call handling options in said initial instant messaging message comprise hyperlinks to the call control system (col.10 line 39-col.11 line 8).

Regarding claim 32, McMullin teaches the call control system of claim 31, further comprising a network server configured to receive a communication connection from the first subscriber initiated by the first subscriber's selection of one of said hyperlink call handling options (col.10 line 39-col.11 line 8).

Regarding claim 33, McMullin teaches the call control system of claim 30, wherein said instant messaging module is further configured to receive a return instant messaging message from the first subscriber, wherein said return instant messaging message includes a selection of one of said call handling options (col.9 line 46-col.10 line 4).

Regarding claim 34, McMullin teaches the call control system of claim 30, further comprising an audio module configured to establish an audio connection with the first subscriber if the first subscriber selects a call handling option for answering the call (col.11 lines 28-56).

Regarding claim 35, McMullin teaches the call control system of claim 34, wherein said audio module is further configured to establish an audio connection with the first subscriber if the first subscriber selects a voicemail with screening option for handling the call (col.7 line 50-col.8 line 4, and col.11 lines 9-56).

Regarding claim 36, McMullin teaches call control system of claim 30, wherein said message playback module comprises a text-to-speech converter ((38 Fig. 2, col.7

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lines 50-67; *subscriber selects text from screen which plays speech to caller, therefore it is a text-to-speech module*).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph T Phan whose telephone number is 703-305-3206. The examiner can normally be reached on M-TH 8:30-6:30, in every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9600.

JTP  
May 30, 2003

*JTP*

FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

